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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,690		Keisuke Tamura	53375/1385	1879

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WASHINGTON, DC 20005

EXAMINER

FINEMAN, LEE A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/812,690

Applicant(s)

TAMURA ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☒ Claim(s) 6-8, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 6) ☐ Other:

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every  
✓ feature of the invention specified in the claims. Therefore, the photo mask of claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The drawings are objected to because of the reasons set forth on the attached PTO-948. Correction is required.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The disclosure is objected to because of the following informalities: On page 14, line 25,  
✓ the backside port is referenced as "102," it should be --100--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawano et al., U.S. Patent No. 5,808,791.

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Regarding claim 1, Kawano et al. discloses in fig. 2 an objective lens (11) disposed below a sample (9), an image-forming lens (15) for focusing observation light from the objective lens, a reflecting mirror (20) for directing transmitted light passing through the image-forming lens to the front side of the microscope (fig 2., right side), a first optical element (16) for directing light from the image-forming lens to an imaging optical path (17b) extending to the backside (fig 2., left side) and disposed between the image-forming lens and the reflecting mirror, a port (column 16, lines 12-13) where the imaging optical path passes through, and an imaging device (column 15, line 57) with an image plane corresponding to the focal plane (fig. 2).

Regarding claim 5, Kawano et al. discloses a lamp housing (2) containing a reflected light source (1) and a reflected illuminator (5) having a shape bent such as to direct light in a predetermined direction (column 5, lines 45-48).

5. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by DeSimone, U.S. Patent No. 5,933,274.

DeSimone discloses a microscope (figs. 3a and 3b) with an objective lens (138), a first light source (165, column, 11, line 52) for emitting excitation light to illuminate the sample (161) via the objective lens, a second light source (155) for emitting a laser beam to illuminate the sample via the objective lens, an image-forming lens (20A, 20B) for focusing the laser beam, and a lens holder (76) for supporting the image-forming lens for the laser beam which enables moving the image-forming lens for the laser beam in a direction of an optical axis of the laser beam for focusing the laser beam (column 4, lines 25-28)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al. in view of Grinblat, U.S Patent No. 6,056,409.

Regarding claim 2, Kawano et al. further discloses a relay lens (21) for relaying the primary image (column 6, line 35) to the focal plane. Kawano et al. discloses the claimed invention except for an adjusting device for changing the distance between the image plane and the focal plane, where the adjusting device is disposed between the port and the imaging device. Grinblat teaches an adjusting device (15) for changing the distance between the image plane and the focal plane (column 4, lines 63-66), where the adjusting device is disposed between the port (11) and the imaging device (12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the microscope of Kawano et al. to include the adjusting device of Grinblat to have independent remote control over the image.

Regarding claim 3, Kawano et al. further discloses and optical axis (column 5, lines 64-67). Kawano et al. discloses the claimed invention except for the adjusting device having the image plane in the direction of the optical axis and the direction perpendicular to the optical axis. Grinblat teaches adjusting device having the image plane in the direction of the optical axis (18) and the direction perpendicular to the optical axis (column 4, lines 5-11 and column 5, lines 46-

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57). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the microscope of Kawano et al. to include the adjusting device of Grinblat to have independent remote control over the image.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al. as applied to claims 2 and 3 above, and further in view of Coates, U.S. Patent No. 4,884,890.

Kawano et al. further discloses viewing optics (22) disposed in an observation optical path (fig. 2) from the reflecting mirror (20). Kawano et al. discloses the claimed invention except for a photo mask. Coates teaches a microscope with a photo mask (column 2, lines 53-55) in the viewing optics (30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the microscope of Kawano et al. to include the photo mask of Coates to accurately adjust the specimen to a desired position.

***Allowable Subject Matter***

8. Claims 6-8 and 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claims 6-8 and 10-11 have allowable subject matter over the prior art for at least the reason that the prior art fails to teach and/or suggest an image-forming lens for the laser beam disposed between the second light source and the third optical element as set forth in the claimed combination.

DeSimone discloses a microscope with a first light source (165, column, 11, line 52) for emitting excitation light to illuminate the sample (161) via the objective lens (138), a second

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optical element (24) for directing the excitation light and transmit observation light from the sample which is disposed in the observation optical path along an optical axis of the objective lens, a second light source (155) for emitting a laser beam to illuminate the sample via the objective lens, an image-forming lens (20A, 20B) for focusing the laser beam, and a lens holder (76) for supporting the image-forming lens for the laser beam which enables moving the image-forming lens for the laser beam in a direction of an optical axis of the laser beam for focusing the laser beam (column 4, lines 25-28). However the image-forming lens is not disposed between the second light source and the third optical element as claimed.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

LAF  
June 17, 2002



Cassandra Spyrou  
Supervisory Patent Examiner  
Technology Center 2800